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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,452	02/20/2002	Christopher F. Claiborne	20832Y	7378
210	7590	12/30/2003	EXAMINER	
MERCK AND CO INC P O BOX 2000 RAHWAY, NJ 070650907			RAO, DEEPAK R	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 12/30/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/079,452

Applicant(s)  
Claiborne et al.

Examiner  
Deepak Rao

Art Unit  
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 6, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 ☒ are pending in the application.
- 4a) Of the above, claim(s) 3-8, 10-39, 41-43, and 45-47 ☒ are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9, and 48-52 ☒ are rejected.
- 7) ☒ Claim(s) 2, 40, and 44 ☒ are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

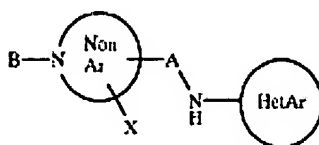
Claims 1-52 are pending in this application.

***Election/Restriction***

Applicant's affirmation of the election of Group I, claims 1-20, 31-41, 43-46 and 48-52 and the species of Example 17 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's amendment overcomes the rejections of record and as per the guidelines of MPEP § 803.02, the search was expanded to cover compounds of formula (I) wherein:

(I)



**HetAr** is pyrimidinyl;

**A** is -C<sub>1</sub>alkyl- (i.e., -CH<sub>2</sub>-);

**NonAr** is 1-piperidin-4-yl; and

**B** is heteroaryl(CH<sub>2</sub>)<sub>1-3</sub>.

Claims 1-2, 9, 40, 44 and 48-52 read on the above subgenus.

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As per the guidelines of MPEP § 803.02, the Markush-type claims were examined to the extent of the searched subgenus. Claims 3-8, 10-20, 31-39, 41, 43, 45 and 46 drawn to compounds of formula (I) wherein **HetAr**, **A**, **NonAr** and **B** are other than those stated for the above subgenus are additionally withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected species. Claims 1-2, 9, 40, 44 and 48-52 are examined to the extent readable on the subgenus as indicated above.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, and 48-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Lommen et al., WO 93/17017. The instantly claimed compounds read on the compounds of the reference, see the reference disclosed compounds in Table 1, pages 45-49, particularly, compounds 38-43. The reference also teaches composition comprising the compounds and further teaches that the compounds are useful in the field of veterinary medicine, see page 37. The intended use recitation in the composition claims is not given any patentable weight.

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*Allowable Subject Matter*

Claims 2, 40 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form limiting to the species wherein HetAr is pyrimidinyl and including all of the limitations of the base claim and any intervening claims.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

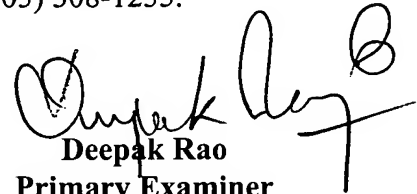
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

December 29, 2003